

REMARKS

Claims 1 and 4 through 12 are pending in this Application, of which claims 7 through 12 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

Accordingly, claims 1 and 4 through 6 are active.

Claims 1 and 4 have been amended and claims 2 and 3 cancelled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure noting, for example, Figs. 2, 6A, 7B, 10 and 11A through 11C, and the related discussion thereof in the written description of the specification. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 1 through 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Minamino et al.

In the statement of rejection the Examiner again concluded that one having ordinary skill in the art would have been motivated to modify the device disclosed by Minamino et al. to include a semiconductor optical module for high speed. This rejection is traversed.

There are fundamental differences between the claimed optical module and that disclosed by Minamino et al. that undermine the obviousness conclusion under 35 U.S.C. § 103. This is because even if the module disclosed by Minamino et al. is modified as suggested by the Examiner, and again Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Specifically, independent claim 1 has been clarified by reciting that the optical subassembly includes a semiconductor optical device therein, wherein the optical subassembly has a co-axial shape. It is not apparent wherein Minamino et al. disclose or suggest any optical subassembly having a co-axial shape.

Further, in accordance with the Examiner's interpretation, optical module 10 disclosed by Minamino et al. is said to correspond to the optical subassembly of the present invention. The Examiner further determined that receptacle 5 of Minamino et al. corresponds to the support of the present invention; cover 6 of Minamino et al. corresponds to the thermal sheet of the present invention; and substrate covers 12, 13 correspond to the bottom end cover of the housing of the present invention. However, receptacle 5 disclosed by Minamino et al. is **different from** the support of the claimed invention. Specifically, the support of the claimed invention includes first and second leg portions, and a bridge connecting the first and second leg portions. It is not apparent wherein Minamino et al. disclose or suggest any support having first and second leg portions, and a bridge connecting the first and second leg portions.

The above argued **fundamental differences** between the claimed module and the module disclosed by Minamino et al. undermine the obviousness conclusion under 35 U.S.C. § 103. As previously pointed out, even if this module disclosed by Minamino et al. is modified as proposed by the Examiner, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

Based upon the foregoing Applicant submits that the imposed rejection of claims 1 through 6 under 35 U.S.C. § 103 for obviousness predicated upon Minamino et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Application No.: 10/717,908

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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